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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/143,318 | 08/28/1998 | TAKASHI YAMANAKA | S004-3484 | 3378 |

7590 01/28/2002
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NEW YORK, NY 10004

EXAMINER

BUDD, MARK OSBORNE

| ART UNIT | PAPER NUMBER |
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2834

DATE MAILED: 01/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR REPLY:

- a) ☒ will expire 5 Mos months from the date of the final Office action (including extensions of time granted).
- b) ☐ expires either (1) three months from the mail date of the final Office action, or (2) on the mail date of this Advisory Action, whichever is later. In no event, however, will the statutory period for reply expire later than six months from the mail date of the final Office action.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's reply to the final rejection, filed 1-10-02 has been considered with the following effect, but it is not deemed to place the application in condition for allowance.

1. ☒ The proposed amendment to the claim and/or specifications will not be entered and the final rejection stands because:

- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The difference between a "conductor" and a "conductive member" is not understood.

2. ☐ Newly proposed or amended claim _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claim allowed: _____

Claims objected to: _____

Claims rejected: 1-8 and 10-21

However;

☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because _____

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other _____

Applicant may obtain further examination by filing a request for an application under 37 CFR 1.53(d) (CPA).

MARK U. BUDD
PRIMARY EXAMINER
ART UNIT 212

Art Unit: 2834

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The drive circuit referred to in the specification as #1- is not described or illustrated in a way that one of ordinary skill in can figure out how it physically and electrically relates to the motor structure.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague indefinite and contradictory in that the power source (claim 1, line 3) is insulated from the piezoelectric material (claim 1 lines 11-15). How can such a device operate if the power source is insulated from the transducer electrodes?

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 9/1, 8 and 9/8 are rejected under 35 U.S.C. 102(a) as being anticipated by Tokusima, Kanazawa or Kawai.

Claims 2, 9/2,3 and 9/3 are rejected under 35 U.S.C. 102(a) as being anticipated by Japan (565) or Sumihara.

Claim 4 and 9/4 are rejected under 35 U.S.C. 102(a) as being anticipated by Sumihara.

Claims 5 and 9/5 are rejected under 35 U.S.C. 102(a) as being anticipated by Inagaki (U.K).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 9/6, 7 and 9/7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai, Tokusima or Kanazawa in view of Japan (783).

The references teach the ultrasonic motor structure except for the provision of a ceramic wear/insulating layer. However, Japan (783) teaches providing a ceramic layer for wear

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protection, while Kanazawa (col. 5 lines 55-68) teaches providing an alumited " insulator on an aluminum stator. Since selection from among known materials has long been obvious to one of ordinary skill in the art to use an aluminum oxide or ceramic wear coating in Kawai, Tokusima or Kanazawa.

Further cited of interest are Shirasaki, Kurozumi and Shirasaki.

Budd/ds

12/14/99

MAKH U. BUDD
PRIMARY EXAMINER
ART UNIT 212